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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,485	11/12/2003	Walter Parsadayan	79449	7594
22242	7590	06/22/2005	EXAMINER	
FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			WOO, STELLA L	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,485

Applicant(s)

PARSADAYAN, WALTER

Examiner

Stella L. Woo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Reissue Applications

1. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

The Certificate under 37 CFR 3.73(b) and Consent of Assignee, filed November 12, 2003 includes a consent by Link Door Controls, Inc. However, a later assignment for U.S. Patent 6,317,489 was recorded on August 13, 2004 to The Chamberlain Group, Inc. at Reel 014981, Frame 0851.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

2. Claims 22-36 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Claim 22 of the present reissue application is broader in scope than claim 6 of the patent by omitting limitations added to overcome an art rejection in the original prosecution, namely, "an outer housing including a door and defining an interior and an exterior, the exterior of the outer housing including said input device; and a substantially closed inner housing, defining an interior and an exterior, removably mounted within the interior of the outer housing; wherein said electronic communication device is within the interior of the inner housing." In the

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amendment filed August 14, 2000, the above-recited outer/inner housing limitation was added to claim 1 (from which claim 6 depends) to obtain allowance of the original patent. Thus, addition of the outer/inner housing limitation has resulted in the surrender of any combination that does not include the outer/inner housing limitation; this is surrendered subject matter.

Reissue claims that are broader than the original patent claims by not including the surrender-generating limitation will be barred by the recapture rule.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 22-31, 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holloway et al. (US 5,982,861, hereinafter "Holloway") in view of Duffy et al. (US 5,303,288, hereinafter "Duffy"), and further in view of Challener et al. (US 5,973,666, hereinafter "Challener").

Regarding claim 22, Holloway discloses a building access control apparatus (entry control panel P) for use with a security system (entry control system) that is operably connected to a communication network (telecommunications facility 14), the access control apparatus comprising:

an input device (12-key numeric keypad; col. 6, lines 38-40);

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an electronic communication device (telephonic interface 38, processing unit 30, memory subsystem 36), the electronic communication device comprising a sequential list of entries (memory subsystem 36 includes directory information; col. 6, lines 28-36);

an output device (display unit 32); and

a scroll apparatus (additional keys, separate from the 12-key numeric keypad, are used to scroll up and scroll down through the directory listing; col. 6, lines 40-42).

Holloway differs from claim 22 in that it does not specify scrolling through the directory listing from a selected entry. However, Duffy teaches the desirability of using “jump character” entry to quickly access the portion of an alphabetical listing, after which scrolling can be initiated using scroll keys (col. 6, lines 14-27) such that it would have been obvious to an artisan of ordinary skill to incorporate such a “jump” function, as taught by Duffy, within the apparatus of Holloway in order to enable a user to quickly access a desired portion of the directory.

The combination of Holloway and Duffy further differs from claim 22 in that the “jump” function is input via keypad entry, not an encoder separate from the keypad. However, Challener teaches the desirability of using a rotary encoder (switch 10) as a user-friendly means for selecting among list entries (col. 2, lines 10-19; col. 6, lines 6-8) such that it would have been obvious to an artisan of ordinary skill to incorporate the use of such a rotary encoder, as taught by Challener, for carrying out the “jump” operation in the combination of Holloway and Duffy in order to simplify the user input process of selecting among the alphabetic characters.

Regarding claim 23, in Holloway, the keypad K includes 12 numeric keys; col. 6, lines 38-40).

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Regarding claims 24, 35, in Holloway, display unit 32 is a four line by forty character LCD (col. 6, lines 13-22).

Regarding claim 25, in Holloway, memory subsystem 36 includes a listing of tenant names and tenant codes (col. 5, lines 41-46; col. 6, lines 27-36; col. 8, lines 59-65).

Regarding claim 26, in Challener, switch 10 has a plurality of positions (see Figure 4).

Regarding claim 27, in Holloway, note processing unit 30.

Method claims 28-29 recite steps carried out by the combination of Holloway, Duffy and Challener as described above.

Regarding claim 30, Duffy teaches the storage of names in a directory in the form of a circular listing so that a user can scroll from the last entry immediately to the first entry and vice versa (col. 6, lines 27-33).

Regarding claim 31, in Challener, switch 10 is a rotary encoder (see Figure 4).

Regarding claim 34, in Holloway, telephone communication is established between the user and the selected tenant via telephonic interface 38 (col. 5, lines 41-52; col. 6, line 28 - col. 7, line 4).

Regarding claim 36, in Holloway, keypad unit 34 includes an "enter" key which is used to select a tenant to be called (col. 6, lines 36-56).

5. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holloway, Duffy and Challener, as applied to claims 22 and 24 above, and further in view of Brodbeck (US 4,408,101).

The combination of Holloway, Duffy and Challener differs from claims 32 and 33 in that the encoder of Challener is a rotary encoder, not a linear encoder. However, Brodbeck teaches

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the well known use of a linear encoder (see Figure 4) for jumping through a telephone number index such that it would have been obvious to an artisan of ordinary skill to use a linear encoder, as taught by Brodbeck, as an alternative to the rotary encoder of Challenger within the combination of Holloway, Duffy and Challenger.

Allowable Subject Matter


6. Claims 1-21 are allowed.

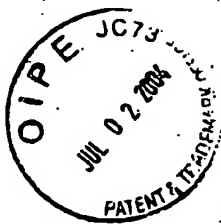
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (571) 272-7512. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Stella L. Woo
Primary Examiner
Art Unit 2643

**BEST AVAILABLE COPY****ATTORNEY DOCKET
NO. 79449****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****Reissue Patent Application Transmittal**

Applicant(s): Walter Parsadayan)

Application For Reissue of)
No: Patent 6,317,489)

Filed: Herewith)

Title: ENTRY PHONE APPARATUS AND)
METHOD WITH IMPROVED)
ALPHABETICAL ACCESS)Group Art)
Unit:)

Examiner:)

DECLARATIONCommissioner of Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

I, WALTER PARSADAYAN hereby declare that:

1. My residence, post office address and
citizenship are as stated below next to my name.2. I verily believe myself to be the original,
first and joint inventor of the subject matter which is
claimed in the present application for which I solicit a
reissue patent on the invention entitled "Entry Phone
Apparatus And Method With Improved Alphabetical Access".3. I have reviewed and understand the content of
the Specification, including the Claims 1 through 36 of the
present application.

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Attorney Docket No. 79449

4. The entire title of U.S. Letters Patent No. 6,317,489 entitled, "Entry Phone Apparatus And Method With Improved Alphabetical Access" (the '489 patent) which issued November 13, 2001, is vested in Link Door Controls, Inc.

5. I acknowledge the duty to disclose information which is material to the examination of the present application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

6. There is no foreign application for patent or inventor's certificate on this invention filed by me or my legal representatives or assigns having a filing date before that of the application on which priority is claimed.

7. I believe the aforesaid Letters Patent 6,317,489 to be wholly or partly inoperative by reason of claiming less than I had a right to claim in the patent. More specifically, I believe that the independent Claim 1 is too narrow in that it claims an outer housing and substantially enclosed inner housing within the outer housing which terminology has been removed from the added independent claim 22.

8. All errors corrected in this re-issue application arose without any deceptive intent on the part of the applicants.

9. All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

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Attorney Docket No. 79449

Full name of sole or one
joint inventor:Walter Parsadayan

Inventor's signature:

6,29,04631748

Date:

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City and Country for others)

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Citizenship:

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Patent Assignment Abstract of Title

Total Assignments: 4**Application #:** 08989532 **Filing Dt:** 12/12/1997**Patent #:** 6317489**Issue Dt:** 11/13/2001**PCT #:** NONE**Publication #:** NONE**Pub Dt:****Inventor:** WALTER PARSADAYAN**Title:** ENTRY PHONE APPARATUS AND METHOD WITH IMPROVED ALPHABETICAL ACCESS**Assignment: 1**

Reel/Frame: <u>008911/0058</u>	Received: 01/30/1998	Recorded: 12/12/1997	Mailed: 03/07/1998	Pages: 3
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Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignor:** PARSADAYAN, WALTER**Exec Dt:** 12/09/1997**Assignee:** ELITE ACCESS SYSTEMS, INC.
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Reel/Frame: <u>014705/0962</u>	Received: 11/21/2003	Recorded: 11/17/2003	Mailed: 06/08/2004	Pages: 6
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Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignor:** ELITE ACCESS SYSTEMS, INC.**Exec Dt:** 09/11/2003**Assignee:** LINK DOOR CONTROLS, INC.
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CHICAGO IL 60603-3406**Assignment: 3**

Reel/Frame: <u>015035/0001</u>	Received: 08/02/2004	Recorded: 08/02/2004	Mailed: 08/26/2004	Pages: 8
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Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignor:** ELITE ACCESS SYSTEMS, INC.**Exec Dt:** 09/11/2003**Assignee:** LINK DOOR CONTROLS, INC.
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Reel/Frame: <u>014981/0851</u>	Received: 08/13/2004	Recorded: 08/13/2004	Mailed: 08/16/2004	Pages: 9
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Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignor: LINK DOOR CONTROLS, INC.

Exec Dt: 08/02/2004

Assignee: THE CHAMBERLAIN GROUP, INC.

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Search Results as of: 6/14/2005 12:14:14 P.M.

If you have any comments or questions concerning the data displayed, contact OPR / Assignments at 703-308-9723
Web interface last modified: Oct. 5, 2002